

REMARKS

I. Allowed Subject Matter

Applicants appreciate the Examiner's indication in the Office Action dated February 5, 2008 (the "Action") that Claims 10, 50, 65 and 79 would be allowable if rewritten in independent form. Claims 10, 50, 65 and 79 have been rewritten in independent form and are therefore in condition for allowance as indicated in the Action.

In addition, Claim 30 recites substantially the same subject matter as allowed Claims 10, 50, 65 and 79. Claim 30 stands rejected in the Action under 35 U.S.C. 112 as depending from a single step claim. Claim 30 has been rewritten in independent form and recites more than one step, and therefore, Claim 30 is also in condition for allowance.

Applicants request further consideration of the rejection of Claims 1-9, 11-49, 51-64, 66-78 and 80-86 under 35 U.S.C. § 102(e) and of Claims 20-39 under 35 U.S.C. § 112 in view of the remarks that follow.

II. The Section 112 Rejections

Claims 20-39 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement rejection. The Action states that Claim 20 is a "single step claim" and "therefore fails to comply with the enablement requirement." Applicants respectfully traverse the rejections under Section 112.

Claim 20 recites a method for operating a pharmacy Interactive Voice Response (IVR) system in response to a telephone call by a caller to the pharmacy IVR system. The method includes "identifying a targeted message for playing to the caller using predefined criteria that are based on an identification of a pharmaceutical prescription by the caller."

The recitations of Claim 20 are enabled by the application as filed, *e.g.*, on page 9, lines 6-33. Moreover, Applicants submit that there is no prohibition of single step claims as apparently maintained in the Action. The MPEP § 2164.08(a) discusses that a single means claim, (where a means recitation does not appear in combination with another recited element

for means), can be subject to a rejection under 35 U.S.C. 112, first paragraph. However, Applicants are unaware of a corresponding provision for method claims or single step claims.

Accordingly, Applicants request that the rejections of Claims 20-39 under Section 112 be withdrawn. However, if the rejections under Section 112 are maintained, Applicants respectfully request that an MPEP section or other legal authority relating to single step claims be specifically identified in any subsequent Action.

III. The Section 102(e) Rejections

A. The Independent Claims

The Action takes the position that Hill discloses, *e.g.*, "querying at least one database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message and playing the targeted message to the caller," at paragraph [0021].

However, Hill relates to a pharmacy system **106** that determines whether the prescription to be filled is eligible for processing by a central fill system **108**. *See* paragraph [0021] (cited in the Action). The central fill system **108** is simply a computer-implemented system for processing prescription requests. Paragraph [0021] merely discusses the rules used to determine whether the prescription is eligible for central fill processing, *e.g.*, whether the patient has elected to pick up the prescribed drug after the next delivery by the central fill system **108**, whether the patient allows the prescription to be filled by the central fill system **108**, whether the drug is in the catalog of available products, and the like. Hill states that if a prescription request follows the rules, the pharmacy system **106** performs edit checks and a drug utilization review (DUR) before adjudicating a claim for payment and transmitting the prescription request packet to the central fill system **108**. *See* paragraphs [0021]-[0022].

Although Hill discusses a pharmacy central fill system **108**, Applicants submit that Hill does not mention identifying a targeted message, *e.g.*, based on the identification of a pharmaceutical prescription, or playing the targeted message to the caller as recited in Claim 1. For example, as discussed on page 7, lines 17-32, targeted message systems, methods and/or computer program products according to embodiments of the present invention can

provide the pharmacy and/or other interested parties an ability to provide targeted informational messages, targeted promotional messages, targeted surveys and/or other targeted messages to callers who are filling prescriptions.

In addition, Hill does not appear to be concerned with communicating with consumers filling prescriptions. As such, Hill does not render obvious identifying targeted messages and/or playing the targeted message to a caller.

Accordingly, Hill does not disclose or render obvious numerous recitations of the claims, including at least the recitations emphasized in the independent claims as follows:

1. A method of operating a pharmacy Interactive Voice Response (IVR) system comprising:
answering a telephone call from a caller;
accepting identification of a pharmaceutical prescription from the caller;
querying at least one database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message; and
playing the targeted message to the caller.

20. A method for operating a pharmacy Interactive Voice Response (IVR) system in response to a telephone call by a caller to the pharmacy IVR system comprising:
identifying a targeted message for playing to the caller using predefined criteria that are based on an identification of a pharmaceutical prescription by the caller.

40. A system for operating a pharmacy Interactive Voice Response (IVR) system comprising:
at least one database; and
a module that is configured to query the at least one database using predefined criteria based on an identification of a pharmaceutical prescription from a telephone caller to the pharmacy IVR system, to identify a targeted message based on the predefined criteria and to provide the targeted message to the pharmacy IVR system for playing to the caller.

60. A computer program product is configured to operate a pharmacy Interactive Voice Response (IVR) system in response to a telephone call by a caller to the pharmacy IVR system, the computer program product comprising a computer usable storage medium having computer-readable program code embodied in the medium, the

computer-readable program code comprising:
computer-readable program code that is configured to identify a targeted message for playing to the caller using predefined criteria that are based on an identification of a pharmaceutical prescription by the caller.

74. A pharmacy Interactive Voice Response (IVR) system comprising:
means for answering a telephone call from a caller;
means for accepting identification of a pharmaceutical prescription from the caller;
means for querying at least one database using predefined criteria based on the identification of a pharmaceutical prescription to identify a targeted message; and
means for playing the targeted message to the caller.

Accordingly, Applicants respectfully submit that independent Claims 1, 20, 40, 60 and 74 are not disclosed by Hill. Claims 2-9, 11-19, 21-39, 41-49, 51-59, 61-64, 66-73, 75-78 and 80-86 depend from Claims 1, 20, 40, 60 and 74 and are patentable at least per the patentability of the independent claims. In addition, certain dependent claims are separately patentable for at least the reasons that follow.

B. Dependent Claims 3-9, 11-18, 21, 23-29, 31-38, 41, 43-49, 51-58, 61-73, 75-78 and 80-86

Dependent Claims 3-9, 11-18, 21, 23-29, 31-38, 41, 43-49, 51-58, 61-73, 75-78 and 80-86 depend from Claims 1, 20, 40, 60 or 74 and are patentable for at least the reasons discussed above. In addition, Claims 3-9, 11-18, 21, 23-29, 31-38, 41, 43-49, 51-58, 61-73, 75-78 and 80-86 are separately patentable for at least the reasons that follow.

As discussed above, Hill does not disclose querying at least one database using predefined criteria to identify a targeted message or playing the targeted message to the caller.

Applicants submit that the portions of Hill cited with respect to dependent Claims 3-9, 11-18, 21, 23-29, 31-38, 41, 43-49, 51-58, 61-73, 75-78 and 80-86 merely discuss processing prescription requests at a central processing system according to certain rules and do not relate to identifying targeted messages or playing targeted messages to a caller.

Accordingly, Hill does not disclose or render obvious at least the following recitations of Claims 3-9, 11-18, 21, 23-29, 31-38, 41, 43-49, 51-58, 61-73, 75-78 and 80-86:

- identifying a series of targeted messages and playing a succeeding one of the series of targeted messages to the caller in response to receipt of a caller response to a preceding one of the series of targeted messages (Claims 3, 43, 61 and 75)
- receiving a caller response to the targeted message (Claims 4, 24 and 44)
- logging the caller response (Claim 5, 25 and 45)
- instructing the pharmacy to perform an action in response to the caller response to the targeted message (Claim 6, 26 and 46)
- the predefined criteria are based on the identification of a pharmaceutical prescription and include the age of the patient who is using the pharmaceutical prescription, gender of the patient, medication of the pharmaceutical prescription, last filled date of the pharmaceutical prescription, days supply on last fill a pharmaceutical prescription, original filled date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect (Claim 7, 27, 47, 62 and 76)
- the predefined criteria based on the identification of a pharmaceutical prescription do not include a personal identification of a patient who is using the pharmaceutical prescription (Claim 8, 28, 48, 63 and 77)
- the predefined criteria based on the identification of a pharmaceutical prescription includes the age of the patient, gender of the patient, medication of the pharmaceutical prescription, last filled date of the pharmaceutical prescription, days supply on last fill a pharmaceutical prescription, original filled date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect but do not include a personal identification of a patient who is using the pharmaceutical prescription (Claim 9, 29, 49, 64 and 78)
- the targeted message includes an educational message concerning the pharmaceutical prescription, a message that indicates alternative medications that may be substituted for the pharmaceutical prescription, a message that identifies other items that made be

desired and/or a message that solicits participation in a study related to the pharmaceutical prescription (Claim 11, 31, 51, 66 and 80)

- identifying an educational targeted message concerning the pharmaceutical prescription (Claim 12, 32, 52, 67 and 81)
- identifying an educational targeted message that reminds the caller how to use the pharmaceutical prescription if the last filled date is less than a first threshold and the days supply on the last filled date is greater than a second threshold (Claim 13, 33, 53, 68 and 82)
- identifying a targeted message that indicates alternative medications that may be substituted for the pharmaceutical prescription if the last filled date is less than a first threshold and the days supply on last filled date exceeds a second threshold (Claim 14, 34, 54, 69 and 83)
- identifying a targeted message that indicates other items that may be desired if the gender is female, age exceeds a first threshold, the last filled date is less than a second threshold and the days supply on the last filled date exceeds a third threshold (Claim 15, 35, 55, 70 and 84)
- identifying a targeted message that solicits participation of the patient in a study related to the pharmaceutical prescription if the age of the patient qualifies the patient to participate in a study related to the pharmaceutical prescription (Claim 16, 36, 56, 71 and 85)
- providing additional targeted messages to allow the patient to participate in the study if the patient agrees to participate (Claim 17, 37, 57 and 72)
- querying at least one message database using the predetermined criteria to identify a targeted message (Claim 18, 38, 58, 73 and 86)
- playing the targeted message to the caller (Claim 21 and 41)
- identifying a series of targeted messages for playing to the caller (Claim 23)
- identifying a targeted message that corresponds to the age of the patient, gender of the patient, medication of the pharmaceutical prescription, last fill date of the pharmaceutical prescription, days supply on the last fill of the pharmaceutical

Attorney Docket No. 9392-2
Application Serial No. 10/672,556
Filed: September 25, 2003
Page 30

prescription, original fill date of the pharmaceutical prescription, disease state of the patient, physician of the patient and/or other promotions in effect (Claim 65 and 79)

Accordingly, Applicants submit that at least Claims 3-9, 11-18, 21, 23-29, 31-38, 41, 43-49, 51-58, 61-73, 75-78 and 80-86 are separately patentable and request an indication of same.

CONCLUSION

Applicants submits that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



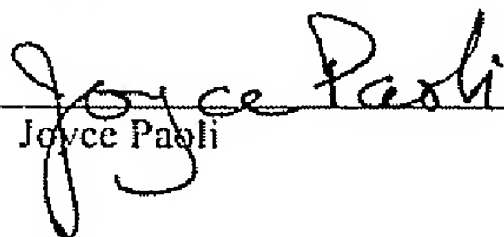
Laura M. Kelley
Registration No.: 48,441

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on March 28, 2008.

Signature: _____


Joyce Paoli